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EXAMINER

HARMON, CHRISTOPHER R

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/559,704
Filing Date: April 27, 2000
Appellant(s): ZOECKLER, MICHAEL D.

Steve McLary
For Appellant

EXAMINER'S ANSWER

This is in response to the Order by the BPAI of 1/5/10 and telephone interview of 1/20/10 regarding the appeal brief filed 9/21/09 appealing from the Office action mailed 5/19/09.

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The Non-Final Rejection of 1/11/10 is hereby **vacated** and the following Examiner's

Answer is set forth below:

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The following new grounds of rejection are also presented:

Claims 3 and 29 as anticipated by Walsh (US 5,746,871) under USC 102(b) or in the alternative unpatentable over Walsh (US 5,746,871) under USC 103(a).

Claims 1-3, 5-7, 11, 13-15, 25-29, 31-33, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNown (US 5,447,270) in view of Walsh (US 5,746,871).

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Claims 1-3, 5-7, 11, 13-15, 25-29, 31-33, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNown (US 5,447,270) in view of Claff (US 2,008,608).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5746871	Walsh	5-1998
5097651	Decottignies et al.	3-1992
5447270	McNown	9-1995
4177715	Meyers	12-1979
2,008,608	Claff	7-1935

(9) Grounds of Rejection

Claims 1, 5-7, 11, 13, 25, 31-33, and 77 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walsh (US 5,746,871).

Walsh discloses a method for forming carton blanks with multiple panels including top, sides and bottom (see column 1, lines 45+) comprising advancing a web of paperboard 2 (with two surfaces) along a path; progressively applying and adhering at least a first and second ribbon of reinforcing material 6 (to a first inner surface) with a width less than the paperboard to edge panel portions; the paperboard has longitudinally extending panel portions defined by fold lines 54 (formed on both sides of the web 2); see figures 2 and 5-6.

Carton blanks are cut from the laminated structure and later formed into a carton (score lines 54 are adjacent to edge of ribbon 6) to form individual carton blanks for

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receiving articles (see figures 1 and 2, column 1, lines 24-65). Because the layers are added thicknesses to an original web, the resulting structure is considered reinforced with the paperboard layer on the outside of the container (strips on the inside).

An additional ribbon 10 is applied to the composite layers in order to adhere/laminate the structure together forming a double thickness of reinforcement and the innermost layer; see figure 1.

The disclosure is not clear as to the exact positioning of the ribbons of reinforcing material with respect to fold lines 54. The figures and disclosure are considered to teach reinforcing both top and bottom panel portions which are defined by longitudinal fold lines 54 by ribbons 6. This would anticipate the claimed limitations as the ribbon 6 would coincide with the fold line 54 and therefore not extend beyond.

As previously argued, appellant takes the viewpoint that ribbon layer 6 extends beyond fold line 54, although this teaching is not supported by the reference. Walsh discloses modified cuts 52 which sometimes extend through ribbon layer 6 (see figures 5-7) however does not provide distinguishing reference numerals for the multiple panel portion cuts other than 52. Thus the examiner provides the following alternate rejection due to the obviousness of positioning reinforcing ribbons as desired:

It would have been obvious to one of ordinary skill in the art to position the reinforcing ribbons without extending beyond the longitudinal fold lines in order to reinforce the top and bottom panels without interfering with the folding procedure in constructing the completed carton.

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Regarding claims 7 and 32, central ribbon 6 is considered overlying an intermediate panel portion as claimed and is applied in order to provide for two adjacent blanks after the cutting procedure, however note that the longitudinal fold lines 54 encompass either side of the are adhered to the opposing edges therefore overlies substantially but not beyond the intermediate panel portion; see figure 2.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh (US 5,746,871) in view of Decottignies et al. (US 5,097,651).

Walsh does not directly disclose printing indicia on the ribbon, however Decottignies et al. teach printing indicia on reinforcing material 5 before adhesion to web 4. It would have been obvious to one of ordinary skill in the art at the time of the invention to include printing indicia as desired for product enhancement.

Claims 78-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh (US 5,746,871) in view of Meyers (US 4,177,715).

Walsh does not directly disclose a third ribbon that is partially adhered to the web however Meyers teaches a process of manufacturing a reinforced paperboard container comprising partially adhering a third ribbon 54 of material to a continuous web 51 not overlying any longitudinal fold lines; see figures 1-3.

The third ribbon is partially adhered to the web 51 to a longitudinal fold line for folding the second unjoined portion into an internal divider for the container.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the process of partially adhering a ribbon as taught by Meyers in the invention to Walsh for providing for a box with an internal partition element as desired.

NEW GROUND(S) OF REJECTION

Claims 3 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walsh (US 5,746,871).

Ribbons 6 are progressively advanced, adhesive applied thereto and adhered to the web 2 as claimed, see above.

Claims 1-3, 5-7, 11, 13-15, 25-29, 31-33, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNown (US 5,447,270) in view of Walsh (US 5,746,871).

McNown teaches manufacturing a paperboard carton with a reinforcing panel portions made of paperboard strips along score lines but not beyond as claimed in order to increase structural integrity; see figure 1c, col. 4, lines 42+.

McNown discusses placing reinforced linerboard on the inside of the box layer (col. 3, lines 24+); strip and patch laminations to selected areas of panels not crossing score lines; see col. 5, lines 29+, Table 3.

McNown does not directly describe the manner of construction of the laminated box blanks shown however Walsh discloses progressively advancing a web of paperboard 2 (with two surfaces) along a path; progressively applying and adhering at least a first and second ribbon of reinforcing material 6 (to a first inner surface) with a width less than

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the paperboard to completely cover edge panel portions; the paperboard has longitudinally extending panel portions defined by fold lines 54 (formed on both sides of the web 2); see figures 2 and 5-6. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the progressive lamination manufacturing techniques as taught by Walsh in the invention to McKnown in order to reinforce edge panel portions with a reduced amount of material and high structural integrity.

Due to arguments presented regarding Walsh not agreed with, ie. that flexible impervious material (Kraft paper, etc.) is not considered a reinforcing layer, the following alternate rejection is presented:

Claims 1-3, 5-7, 11, 13-15, 25-29, 31-33, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNown (US 5,447,270) in view of Claff (US 2,008,608).

McNown provides for reinforced box blank construction, see above, however does not directly disclose the manner of blank production, however Claff discloses a method for forming carton blanks comprising advancing a continuous web of non-corrugated paperboard 1 along a path; progressively applying/laminating material (Kraft paper), with an adhesive, a plurality of ribbons of reinforcing material 2 with a width less than the paperboard substantially overlying substantially all of selected panel portions 3 (ie. portions to become panels in the final construction as interpreted by the Board of Patent Appeals); the paperboard is then scored and cut into individual carton blanks and then are formed into cartons for receiving articles (see figures 1-2 and 6-7).

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Reinforcing strips 2 are progressively folded/sealed/adhered to opposed edge portions of the paperboard web 1; see figure 6 however are disclosed as extending beyond the bottom edge fold line; see column 2, lines 30-37.

McNown however in addition to directly reinforcing fold/score lines teaches aligning reinforcing strips along fold/score lines for reinforcing selected panel portions (including an intermediate); see figures 1a-1c. It would have been obvious to one of ordinary skill in the art at the time of the invention to include progressively applying laminating reinforcing strips as taught by Claff along the fold lines but not extending beyond in the invention to McNown in order to sufficiently increase the structural integrity with reduced cost.

Regarding claims 6 and 33, Claff teaches the possibility of further layer 14 to be added atop first and second reinforcing strips 2; see page 2, left column, lines 38+.

(10) Response to Argument

The previous rejections as presented in the Examiner's Answer have been maintained. Due to ongoing issues with regard to Walsh the examiner provides the above alternate rejections including McNown, as McNown clearly shows reinforcing longitudinal panel portions by reinforcing only adjacent portions of a score line. One of ordinary skill in the art at the time of the invention would have been able to use this teaching for the predictable outcome of reinforcing the selected portions as desired. Note that a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual

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application is beyond that person's skill; see *KSR Int. v. Teleflex 550 US__* (2007).

Progressive application of reinforcing ribbons to a blank material with regard to selected portions thereof is considered within the skill of one of ordinary skill in the art.

During patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 320,322 (Fed. Cir. 1999). In determining the patentability of claims, the PTO gives claim language its broadest reasonable interpretation" consistent with the specification and claims. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See MPEP § 904.1. Limitations not appearing in the claims cannot be relied upon for patentability; *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Particular embodiments appearing in the written description are not to be read into the claims if the claim language is broader than the embodiment; see *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed.Cir. 2004).

Regarding the reinforcing ribbons of Walsh, note that any additional layer in a laminated structure will inherently provide additional structural reinforcement given the properties of the layer as well as the properties of any adhesive applied. Walsh clearly shows laminating/combining multiple layers of web ribbons together in order to form material to be processed into packaging blanks; as shown in figures 1-12/

Regarding the fold lines of Walsh, note that Walsh clearly depicts longitudinal fold lines as noted supra. In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., performing a folding process prior to adhering ribbons of

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reinforcing material) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The web is advanced as claimed.

Regarding the positioning of ribbons in relation to fold lines, note that one of ordinary skill in the art could easily recognize problems with folding laminated structures as this problem is recognized and is replete throughout the prior art including the cited prior art of record; Walsh accomplishes relief for transverse fold lines (also labeled 52) by cutting away portions 64 of the rigid layers; see figure 5; McNown figure 1c, col. 4, lines 50+; Mathieu et al. (US 6,015,084); Balin (US 4,905,864); Knecht (US 5,393,295)

Note that the alleged ambiguity of Walsh is not sufficient to provide novelty to the claims. One of ordinary skill in the art would easily recognize that problems might exist when folding laminated thicknesses of webs including slippage, bubbling, buckling, etc. as is taught throughout the prior art. One of ordinary skill in the art is not an automaton; see *KSR Int. v. Teleflex* 550 US__ (2007). The modification of positioning the outer layer with respect to the inner layer is not more than the predictable use of prior-art elements according to their established functions.

Figure 2 of Walsh shows a wider strip 6 in the middle which is then cut so as to provide edge reinforcement sections extending on the two opposing longitudinally extending sides. Fold lines 54 are "formed in the relatively rigid material 2"; see column 3, lines 43+. There is no mention of fold lines 54 being formed in strip material 6 but only in material 2; see col. 3, lines 42+. Note that the discussion of cut lines is specific

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to each layer see column 4. The proportionality argument presented on page 13 is not agreed with or persuasive. Note when the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int 'l*, 222 F.3d 951(Fed. Cir. 2000); MPEP 2125.

Walsh discloses multiple embodiments in Figures 1-12. Appellants arguments to single specific figures are not agreed with as they present mere speculation as to the scope of the complete teachings of Walsh.

Claim 7 and 32 are addressed supra as the issue raised is the same as that to claim 1.

Regarding Decottignies, the arguments presented are merely speculative and are not agreed with. The claims fail to distinguish over the prior art. While evaluating obviousness, one must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions; see *KSR Int. v. Teleflex* 550 US__ (2007).

To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art; *ibid*.

The analysis need not seek out precise teachings directed to the challenged claimed specific subject matter, for a court can consider the inferences and creative

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steps a person of ordinary skill in the art would employ. Under the correct analysis, any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed; *ibid.*

Regarding McNown, McNown clearly shows reinforcing longitudinal panel portions by reinforcing only adjacent portions of a score line. One of ordinary skill in the art at the time of the invention would have been able to use this teaching for the predictable outcome of reinforcing the selected portions as desired. Note that a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill; see *KSR Int. v. Teleflex 550 US__* (2007).

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment,

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affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.


Respectfully submitted,

/Christopher R Harmon/

Primary Examiner, Art Unit 3721

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A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:


Karen M. Young
TC 3700 Director

Conferees:

/Rinaldi I Rada/
Supervisory Patent Examiner, Art Unit 3721

/Henry Yuen/
Special Programs Examiner, TC 3700